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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/632,030      | 07/31/2003  | Hiromi Yunoki        | 2003-1956.CIP       | 9655             |

23165 7590 02/02/2005

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| EXAMINER |
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NGUYEN, CAM N

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| ART UNIT | PAPER NUMBER |
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1754

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/632,030

Applicant(s)

YUNOKI ET AL.

Examiner

Cam N Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/31/03 (a CIP of application 10/615435)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 1-3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1-3 are objected to because of the following informalities:
  - A. In claim 1, line 1, "A production process for a catalyst" should be changed to --A process of producing a catalyst--.
  - B. In claim 1, line 2, "includes" should be changed to --including--.
  - C. In claim 1, line 3, "with the production process" should be changed to --the process--.
  - D. In claim 1, line 4, "revolution " should be changed to --revolving--.
  - E. In claim 1, line 4, "as" should be deleted.
  - F. In claim 2, line 1, "A production process" should be changed to --The process--.
  - G. In claim 2, line 2, "any one member" should be changed to --a member--.
  - H. In claim 3, line 1, "A production process" should be changed to --The process--.
  - I. In claim 3, line 6, "revolution " should be changed to --revolving--.

Appropriate correction is required.

### *Double Patenting*

2. Claims 1-3 of this application conflict with claims 1-3 of Copending application No. 10/615,435. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

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cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3 are rejected under 35 U.S.C. 101 because they contain the same subject matter as claimed in the copending application No. 10/615,435.

#### ***Claim Rejections - 35 USC § 102(b)***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawajiri et al., "hereinafter Kawajiri", (US Pat. 4,873,217).

Kawajiri discloses a process of preparing a catalyst by coating the catalytic components on a support by using a centrifugal flow coating device (see col. 23, claim 4).

With respect to the limitation on "the step of carrying out simultaneous revolving and rocking of a treatment container charged with the carrier and a catalyst precursor including the catalytic component", it is considered the claims are met by the teaching of the reference because Kawajiri teaches to perform the process using a centrifugal flow coating device, which involves revolving and rocking of the catalytic materials inside of the device at the same time.

Kawajiri discloses the claimed process of preparing a catalyst, thus anticipates the claims.

***Allowable Subject Matter***

8. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Citations**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form prepared attached. All references are cited for related art.

**Conclusion**

10. Claims 1-3 are originally pending in the application. Claims 1-3 are rejected. Claims 1-3 are objected. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (571) 272-1357. The examiner can normally be reached on Mon, Wed, Thurs, & Fri from 8:45 am. to 5:15 pm.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number (571) 272-1700.

Nguyen/cnn

*cnn*

January 31, 2005

*Cam Nguyen*  
CAM N. NGUYEN  
PRIMARY EXAMINER

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